

Group II, Claims 22-26, drawn to method of assembling a rotating machine, classified in Class 29, subclass 598.

In support of the present restriction requirement, the Examiner alleged that the subject matter defined by the claims of the present invention represents two distinct inventions stating that:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case the apparatus as claimed can be used in a generator and made by a materially different process such as welding without a molten salt bath.

Accordingly, it is in the Examiner's position that each group of claims requires individual consideration as to patentability.

As indicated, and in order to be fully responsive to the Examiner's requirement for restriction, applicants provisionally elect to prosecute the subject matter of Group I, Claims 1-21, and reserve the right to file a divisional application directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. § 1.111, applicants hereby traverse the restriction requirement and request reconsideration thereof in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. § 121, first sentence (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions, which are both

independent and distinct, 37 C.F.R. §§ 1.141-142. Without independence and distinctness, a restriction requirement is unauthorized.

Even assuming, pro arguendo, that the Examiner was correct in a showing of distinctness, there is absolutely no indication that Groups I and II are also independent. Therefore, in light of the foregoing statutory and regulatory criteria, the present restriction requirement cannot be maintained since it lacks a showing that allegedly several inventions are independent, one from the other.

In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. The claims of Group I, namely Claims 1-21 are directed to an apparatus of a rotating machine, while the claims of Group II, namely Claims 22-26, are directed to a method of assembling the rotating machine. The rotating machine of Claims 1-21 cannot be considered "independent" of Claims 22-26, drawn to a method for assembling the rotating machine. Thus, Claims 22-26 are very clearly interrelated and interdependent on Claims 1-21, not "independent and distinct."

The interdependence of the rotating machine and the method for assembly of the same is confirmed --indeed, it is mandated --by virtue of the fact that the description requirements of 35 U.S.C. § 112 compel disclosure of both aspects of the invention in the one application which applicants have filed. An application claiming a rotating machine is required to disclose inter alia the method for assembly of the rotating machine to fully enable the invention.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCA 1973) (Emphasis added).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit

has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that § 121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

The particular reason given by the Examiner to justify restriction between Groups I, and II, under M.P.E.P. § 806.05(e), is that they are related as process and apparatus for its practice. It is respectfully submitted that such a reason is insufficient to support this restriction requirement. In fact, reference to the Manual of Patent Examining Procedure does not establish compliance with the narrow statutory authorization for restriction requirements. The Manual simply states the policy of the Patent and Trademark Office without force of law; it is not authority for expanding or altering a statutory grant of authority.

The PTO can prescribe requirements in the MPEP, providing those requirements are not

inconsistent with the statute, the rules or  
the case law of the PTO's reviewing court.  
In re Ressola, 22 U.S.P.Q. 2d 1828, 1832  
(Comm'r. PTO, 1992).

The fact is, as demonstrated above, that aspects of the invention which have been deemed separable by the Examiner under the guidelines of M.P.E.P. § 806.05(e) are nonetheless not independent and distinct; therefore, the Manual is not proper authority for requiring restriction here.

The Examiner also argues that the inventions have acquired a separate status in the art as shown by their different classification as another reason for the restriction.

Applicants' respectfully submit that reliance on the supposed classification of the groups of claims also does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents.

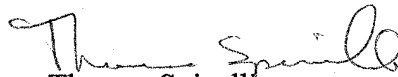
The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent the Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass(es) with which he associated with another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed,

classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. § 121, which fact proves that basing restriction requirements on the classification system is improper.

For the reasons stated hereinabove, it is again respectfully urged that the Examiner withdraw the requirement for restriction and provide an action on the merits with respect to all the claims. However, if the restriction requirement is maintained, applicants provisionally elect Group I, i.e., Claims 1-21.

Respectfully submitted,

  
Thomas Spinelli  
Registration No.: 39,533

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343

TS/cm